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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,525	11/13/2001	Aemilianus G. J. Staring	PHN 14989R	1690
24737	7590	12/22/2005	EXAMINER	
PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510			PATEL, ASHOK	
			ART UNIT	PAPER NUMBER
			2879	

DATE MAILED: 12/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H/A

Office Action Summary**Application No.**

10/053,525

Applicant(s)

STARING ET AL.

Examiner

Ashok Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Applicant's arguments filed 08/01/2005 have been fully considered but they are not deemed persuasive.

2. The instant U.S. Patent Application 10/035,535 is a Reissue of U.S. Patent Application S.N. 09/891,611 (now U.S. Patent No. 5,986,400), which is a divisional of U.S. Patent Application 08/523,837 (now U.S. Patent No. 5,705,888).

Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which U.S. Patent No. 5,986,400 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation. Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application. These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

3. Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173(b), 37 CFR 1.173(d).

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4. The Examiner noted that content of the instant re-issue application does not mention any reference to the foreign application filing.

5. Claims 1-3 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue application, which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the U.S. Patent cannot be recaptured by filing of the reissue application. *Ex Parte Eggert*. See MPEP § 1412.02.

The Examiner noted that during prosecution of the U.S. Patent Application 09/891,611 (now U.S. Patent 5,986,400), claims 4 and 6 were cancelled due to a reason that they were allowed in its parent U.S. Patent Application 09/523,837 (now U.S. Patent. 5,705,888).

The (broader) limitation "active layer made from a semiconducting conjugated soluble polymer" as recited in reissue application claim 3, lines 1-2, provides the "broadening aspect" compared to the (narrow) limitation "active layer made from a semiconducting conjugated polymer selected from poly (3-alkylthiophene) and poly (p-phenylene vinylene) polymers" as recited in claim 1 of the original U.S. Patent 5,986,400.

The narrow limitation, in combination with other elements of the device, defined claim 1 of the U.S. patent 5,986,400 patentable over prior art.

The broad limitation "active layer made from a semiconducting conjugated soluble polymer" in the reissue application claim 3 is broader than cancelled claim 4 or 5 of the original application 09/891,611 (or broader than allowed claims 4 or 5 of U.S. Patent. 5,705,888, since cancellation of claims 3 and 4 in the application 09/891,611 was due to their allowablity in the parent U.S. Patent. 5,705,888). Therefore, the recapture exists.

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6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 5,705,888. Although the conflicting claims are not identical, they are not patentably distinct from each other because the combined scope of claims 1-5 of U.S. Patent No. 5,705,888 recites applicant's claimed electroluminescent device including: an active layer, and first electrode layer and second electrode layer, including composition of the active layer and the first electrode as claimed by applicant. Claim to claim comparison is as follows:

Claims of U.S. Patent Application S.N. 10/053,525	Claims of U.S. Patent 5,705,888
Claim 1	Claim 1, 3

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Claim 2	Claim 4, 5
Claim 3	Claim 4, 5

8. The Examiner replies to applicant's arguments, filed on 088/01/2003, as follows.

Applicant argues, at paragraph bridging pages 3 and 4, that the limitation "active layer made from a semiconducting conjugated polymer selected from poly (3- alkylthiophene) and poly (p-phenylene vinylene) polymers" was not added to claim 1 of the original patent (claim 13 of the original application) in order to define patentable subject matter over any prior art. Applicant further argues that the limitation was added to "more clearly define the invention". Still further applicant argues that: "In the Office action of 15 March 1999 following the above-described amendment of claim 13, rather than applying any prior art in response to the amendment, the Examiner instead dropped the prior rejection of claim 13 under Section 103, and rejected the claims for double patenting over prior patent 5,705,888.

The Examiner disagrees with applicant since the added limitation "active layer made from a semiconducting conjugated polymer selected from poly (3- alkylthiophene) and poly (p-phenylene vinylene) polymers" rendered claim 1 of the U.S.

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Patent Application S.N. 08/891,611 patentable under 35 U.S.C. 103, not merely due to the "more clearly defined invention".

Applicant argues that claims 4 and 5 of the original application 08/891,611 were not cancelled in view of prior art rejection, but was cancelled because they had already been allowed in the parent application 08/523,837, now U.S. Patent 5,705,888. The Examiner agrees with applicant. It is self evident that cancellation of claims 4 and 5 in the original application 08/891,611 was due to their allowability in the parent application 08/523,837, now U.S. Patent 5,705,888.

Applicant argues, at page 4, paragraph 4, that: neither the amendment of claim 13 in the original application was made for or necessitated by the prior art.

The Examiner disagrees for reasons given earlier and repeats that: the added limitation "active layer made from a semiconducting conjugated polymer selected from poly (3-alkylthiophene) and poly (p-phenylene vinylene) polymers" rendered claim 1 of the U.S. Patent Application S.N. 08/891,611 patentable under 35 U.S.C. 103, not merely due to the "more clearly defined invention".

Applicant further argues, at page 4, paragraph 4, that: accordingly, claim 3 of this reissue application is not an attempt to recapture subject matter previously given up in order

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to define patentable subject matter, but rather is an attempt to claim subject matter which Applicant is entitled to claim but failed to claim previously through error. Applicant further argues that: this is exactly the kind of situation which a reissue patent with broadened claims is designed to remedy.

The Examiner disagrees with applicant since broadening of claim 3 in this reissue application is recapture of the subject matter, which was given up previously in the original U.S. Patent application S.N. 08/891,611 for defining patentable subject matter.

Regarding obviousness-type double patenting rejection applicant argues at pages 4 and 5 that neither of claims 4 and 5 of U.S. Patent 5,705,888 calls for an active layer comprising poly (3-alkylthiophene) or its derivatives.

The Examiner realizes that claim 4 or claim 5 of U.S. Patent 5,705,888 does not call for active layer comprising poly (3-alkylthiophene) or its derivatives. However, claim 4 or claim 5 of U.S. Patent 5,705,888 clearly calls for active layer comprising poly (p-phenylene vinylene) polymers, as recited in claims 1 and 3 of the reissue application.

The Examiner noted presence of the claimed markush grouping "selected from the group consisting of polymers of element a (poly (3-alkylthiophene) and element b (poly (p-phenylene

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vinylene)" as recited in claims 1 and 3 of the reissue application, which means the active layer includes either element "a" or element "b" or elements "a and b together".

Applicant argues, at the middle of page 5 that, claim 3 of the reissue application calls for the semiconducting conjugated polymer to be soluble. It is the Examiner's position that the poly (3-alkylthiophene) and poly (p-phenylene vinylene are soluble polymers.

Applicant further argues, at the middle of page 5 that, claim 3 of the reissue application does not call for the insulating areas in the first electrode layer.

Applicant's this arguments is moot since none of the claims 1-3 of the reissue application recites the feature of the insulating areas in the first electrode layer. Argument has to be related to claimed subject matter.

Accordingly is is the position of the Examiner that rejection of claims 1-3 under 35 U.S.C 251 and under obviousness-type double patenting is proper.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this

action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashok Patel whose telephone number is 571-272-2456. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nimesh Patel can be reached on 571-272-2457. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private

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PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ashok Patel
Primary Examiner
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